

REMARKS

The applicants have carefully considered the office action dated November 12, 2009, and the references it cites. By way of this response, claims 2-8, 10, 11, 14-16, 18-26, 28, 30, 32-40, 42, 44, 46 and 47 have been amended, and no claims cancelled. In addition, claim 86 has been added. All claims are supported by the specification, and no new matter has been added. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

The Double Patenting Rejection

Claim 2 is rejected on the grounds of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,513,161. Without commenting on the merits of this rejection, the applicants note that no claims of this application have been allowed. Accordingly, the applicants will address this rejection in the future, to the extent necessary.

The 35 U.S.C. § 102 Rejections

Claims 2-16, 18-30, 32-44, 46 and 47 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Kiewit (U.S. 4,697,209). The applicants respectfully disagree.

Independent claim 2 is directed to a system for determining an operating mode of a recording/playing device. The system includes a first monitor configured to detect a first media signal output by a tuner configured to tune to a program signal, a second monitor configured to detect a second media signal output by a recording/playing device configured to at least one of record and play a program, a third monitor configured to detect a third media signal output by a receiver coupled to the recording/playing device and a fourth monitor configured to detect a recording signal generated by the recording/playing device only during recording of the program to form a recorded program. The system also includes a mode identifier coupled to the first, second, third, and fourth monitors and configured to identify an operating mode of the recording/playing device based on a comparison of the first

and second media signals, a comparison of the second and third media signals, and a presence or absence of the fourth signal. Therefore, the recited system includes the following:

- first media signal output by a tuner
- second media signal output by a recording/playing device
- third media signal output by a receiver
- fourth signal that is a recording signal
- a comparison of the first and second media signals
- a comparison of the second and third media signals
- a presence or absence of the fourth signal

In contrast, Kiewit describes a system in which a mode of a VCR is determined by comparing the on/off signals of a TV and a VCR and a recording signal of a VCR. *See* Kiewit FIG. 3 and col. 6, lines 2-19. FIG. 3 of Kiewit shows that there is no comparison of a first media signal output by a tuner with a second media signal output by a recording/playing device, as recited in claim 2. The present action at page 5 asserts that Kiewit shows detecting if the first and second signals match because Kiewit describes in col. 5, lines 55-57 that “Mode 3 [VCR recording] represents recording by the home VCR and occurs when the television receiver is off and the VCR is on.” Thus, the cited portion of Kiewit describes an analysis that involves a receiver signal and a recording/playing device signal. However, the cited portion of Kiewit does not describe comparing a first media signal output by a tuner with a second media signal output by a recording/playing device. Therefore, Kiewit fails to describe all recitations of claim 2.

It is well settled that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Thus, because Kiewit fails to describe all of the recitations of claim 2, Kiewit cannot anticipate claim 2 or any claims that depend therefrom.

Claims 20 and 34 have recitations similar to that of claim 2, discussed above. Therefore Kiewit cannot anticipate claims 20, 34 or any of their dependent claims for at least the reasons detailed above.

The 35 U.S.C. § 103 Rejections

Claims 17, 31 and 45 are rejected under 35 U.S.C. §103(a) as allegedly obvious over Kiewit in view of Vitt (U.S. 5,165,069).

As noted above, Kiewit does not describe comparing a first media signal output by a tuner with a second media signal output by a recording/playing device. Vitt was not cited for the premise of describing this claim limitation, and the cited portions of Vitt do not describe comparing a first media signal output by a tuner with a second media signal output by a recording/playing device.

As discussed above, none of the cited portions of the prior art describe comparing a first media signal output by a tuner with a second media signal output by a recording/playing device. Therefore, the combinations of Kiewit and Vitt used as the bases for the obviousness rejections do not teach or suggest all of the recitations of the claims. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. “All of the words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Consequently, the obviousness rejection for all outstanding claims cannot stand and the claims are in condition for allowance.

New Claim 86

New claim 86 depends from claim 2 and, thus, is allowable for at least the reasons discussed above. Furthermore, Kiewit monitors whether a television or VCR are on or off but does not compare video and/or audio content of signals output by a tuner with video and/or audio content signals output by a recording/playing device, nor does Kiewit compare

video and/or audio content signals output by a recording/playing device with video and/or audio content signals output by a receiver, as recited in claim 86. Therefore, claim 86 is allowable for this reason alone.

Conclusion

Based on the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance. If the examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the examiner is invited to contact the undersigned at the number identified below.

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. Please refund any overpayment to Hanley, Flight & Zimmerman, LLC at the address below.

Respectfully submitted,

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